

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

Claims 1-35 were pending in this application. Claims 2 and 35 have been cancelled and claim 1 has been amended to include the subject matter of cancelled claim 2. Accordingly, claims 1 and 3-34 will be pending herein upon entry of this Amendment. For the reasons stated below, Applicants respectfully submit that all claims pending in this application are in condition for allowance.

In the Office Action, claim 1 was rejected under 35 U.S.C. §102(b) as being anticipated by Pöyhönen; claims 3-39 [sic, 35] were rejected under 35 U.S.C. §102(b) as being anticipated by Mölne; and claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Pöyhönen in view of Mölne. To the extent these rejections might still be applied to claims presently pending in this application, they are respectfully traversed.

Applicants first address the rejections of claims 1 and 2, noting that the subject matter of claim 2 has now been incorporated into amended independent claim 1. This combined claim stands rejected as being obvious over a combination of Pöyhönen and Mölne.

Applicants note that the burden of establishing a prima facie case of obviousness lies with the Patent Office. In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). To establish a prima facie case of obviousness, there must be (1) some suggestion or motivation (either in the references themselves or in the knowledge generally available to one of ordinary skill in the art) to modify the reference or to combine reference teachings to achieve the claimed invention, and (2) the

prior art must teach or suggest all the claim limitations. MPEP §2143. Also, simply because the references could be combined, does not mean they should be. MPEP §2143.01, citing In re Mills, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

It is evident from any fair reading of the cited references that not all of the claimed limitations of amended claim 1 are actually taught or suggested, and thus the suggested combination of Pöyhönen and Mölne does not fulfill the second prong of the test for a prima facie case of obviousness. Specifically, while Mölne clearly discloses a SIM card that includes a plurality of fields for controlling a mobile device, the fields disclosed by Mölne do not suggest the specific files required by amended claim 1. For instance, amended claim 1 requires individual files that

1. dictate in what order to scan frequency bands when the MS powers up;
2. contain location areas that are to be considered as a part of a home network
3. dictate which frequency bands to scan when the MS is in a home MCC but not within home network LACs,
4. dictate in what order to scan frequency bands within the home MCC,
5. dictate which frequency bands to scan when the MS is not in the home MCC, and
6. contain location areas of preferred networks.

The fields identified and depicted in Fig. 3 (and described in the corresponding disclosure) of Mölne do not correspond to the “files” recited in amended claim 1. For instance, Mölne does not disclose a field for a scanning order of frequency bands, nor does Mölne disclose

a field that contains location areas (LAs). Consequently, any combination of Pöyhönen and Mölne would never result in the present invention as recited in amended claim 1.

Applicants acknowledge that they are not the first to propose storing information on a SIM that can facilitate how a mobile device will operate in conjunction with a network. On the other hand, Applicants do respectfully submit that they are the first to describe and claim the particular SIM files as recited in amended claim 1.

Regarding the §103 rejection of independent claim 3, the claim requires: scanning frequency bands, and that a home network location area code (LAC) be defined in a file in a SIM. Mölne describes scanning control channels (which is well-known), but does not disclose whether these control channels span from one band to another. In the present application, “band” has the meaning 800 MHz, 900 MHz, 1800 MHz and 1900 MHz (see, e.g., paragraph [0031]). Typically, there are control channels in each one of these bands. Mölne is silent as to whether scanning is performed across bands. As such, Mölne does not actually teach the recited limited limitation.

Additionally, the portion of Mölne cited as allegedly disclosing that a LAC is defined in a first file in a SIM is actually a discussion of a field that is used to identify a PLMN via MCC/MNC. There is no discussion in the cited portion (or anywhere else) of Mölne that describes storing LACs in a SIM.

Independent claim 25 recites similar subject matter, but in the context of a “reselection” process.

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Independent claim 16 is also directed to a "reselection" process in a GSM network, and not only recites the band scanning limitation discussed above, but further requires that the SIM include an indication or "period" after which scanning should reoccur. Mölne also does not disclose a SIM with this functionality. Independent claim 19 includes similar limitations, and should be allowable over Mölne for at least the same reasons claim 16 is allowable.

For at least the reasons discussed above, Applicants respectfully urge that the §102 and §103 rejections of the claims be reconsidered and withdrawn.

In view of the foregoing all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone applicants' undersigned representative at the number listed below.

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Respectfully submitted,

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Attachments: None

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